

REMARKS

Reconsideration of the present application, as amended, is respectfully requested. Claims 1-66 are presented for reconsideration.

1. Summary of the Office Action

Examiner rejected claims 1-3, 6, 9-11, 19-22, 26, 31, and 37-40 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent Application No. 2002/0171737 to Tullis in view of U.S. Patent No. 6,606,669 to Nakagiri and further in view of U.S. Patent No. 6,353,848 to Morris.

Examiner rejected claims 4, 12, and 17-18 under 35 U.S.C. §103(a) as being unpatentable over Tullis in view of Nakagiri and further in view of Morris as applied to claim 1 above, and further in view of U.S. Patent No. 6,628,325 to Steinberg et al.

Examiner rejected claims 7-8 and 16 under 35 U.S.C. §103(a) as being unpatentable over Tullis in view of Nakagiri and further in view of Morris as applied to claim 1 above, and further in view of U.S. Patent Publication No. 2003/0142215 to Ward et al.

Examiner rejected claims 13-15 under 35 U.S.C. §103(a) as being unpatentable over Tullis in view of Nakagiri and further in view of Morris and further in view of Steinberg as applied to claim 12 above, and further in view of U.S. Patent No. 5,737,491 to Allen et al.

Examiner rejected claims 23-25, 29-30, and 32 under 35 U.S.C. §103(a) as being unpatentable over Tullis in view of Nakagiri and further in view of Morris as applied to claim 21 above, and further in view of Steinberg.

Examiner rejected claims 27-28 and 36 under 35 U.S.C. §103(a) as being unpatentable over Tullis in view of Nakagiri and further in view of Morris as applied to claim 21 above, and further in view of Ward.

Examiner rejected claims 33-35 under 35 U.S.C. §103(a) as being unpatentable over Tullis in view of Nakagiri and further in view of Morris as applied to claim 21 above, and further in view of Allen.

Examiner rejected claims 41, 43-45, 51, 59, and 62 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,005,613 to Endsley et al. in view of Nakagiri, further in view of Morris.

Examiner rejected claims 42, 49-50, 52, and 57-58 under 35 U.S.C. §103(a) as being unpatentable over Endsley in view of Nakagiri, further in view of Morris as applied to claim 41 above, and further in view of Steinberg.

Examiner rejected claim 46 under 35 U.S.C. §103(a) as being unpatentable over Endsley in view of Nakagiri, further in view of Morris as applied to claim 41 above, and further in view of U.S. Patent No. 6,535,243 to Tullis et al.

Examiner rejected claims 47-48, 56, and 61 under 35 U.S.C. §103(a) as being unpatentable over Endsley in view of Nakagiri, further in view of Morris as applied to claim 41 above, and further in view of Ward.

Examiner rejected claims 53-55 under 35 U.S.C. §103(a) as being unpatentable over Endsley in view of Nakagiri, further in view of Morris as applied to claim 41 above, and further in view of Steinberg and further in view of Allen.

Examiner rejected claim 60 under 35 U.S.C. §103(a) as being unpatentable over Endsley in view of Nakagiri, further in view of Morris as applied to claim 41 above, and further in view of U.S. Patent No. 6,529,969 to Inoue.

2. Response to 35 U.S.C. §103(a) rejections

Teaching Away & Modification of Principle of Operation Denies Combination

Regarding Tullis/Nakagiri/Morris combination, Applicants respectfully submit that there is the combination suggested by the Examiner is not proper. In particular, the combination would render Tullis not suitable for its original purpose and would change the principle of operation of the prior art invention being modified (as per MPEP 2143.01).

In particular, Tullis specifically teaches away from “establishing a communication session supporting photo-serving communication protocols that present the digital camera device as a file server to the host device,” by stating that “the camera can display previously captured images by accessing image data that is stored in the host computer. For example, the hand-held digital camera can access and display an image that was captured the previous day, since the data is stored in the host computer. (Tullis, paragraph 11, emphasis added). Thus, since in Tullis the data is stored in the host computer in the system of Tullis, the camera device cannot not act as a file server, since there is no data for it to serve.

Modifying Tullis in order to incorporate a file server would render Tullis not suitable for its original purpose, and would change the principle of operation of Tullis. The focus of Tullis, the principle of operation, is to store the data on the host system, and thus remove the need to store data on the digital camera. Changing Tullis to

having a digital camera that acts as a file server for the host system would fundamentally alter the principles of operation of Tullis.

Therefore, Applicants respectfully submit that Tullis cannot be logically combined with Morris and Nakagiri, to include the functionality of a file sever into the camera of Tullis. Applicants respectfully submit that the combination is improper, and the claims cannot be rejected over Tullis in combination with Nakagiri and Morris. Applicants therefore respectfully request the withdrawal of this rejection.

Furthermore, Even the Combination does not make the Invention Obvious

Furthermore, even in combination, Tullis, Nakagiri, and Morris do not make the present invention obvious. Claim 1 recites in part “the digital camera device ... **based on said determined communication information**, establishing a communication session between the digital camera device and the particular host device, said communication session supporting photo-serving communication protocols that present the digital camera device as a file server to the host device.”

As noted in a previous response, the phrase “based on said determined communication information” makes no sense in the context of the cited passage for at least the reason that there is no mention of determining communication information. Furthermore, none of the references teach or suggest this limitation. In particular, in Morris, there is no need for the digital camera to determine communication information, because, in Morris, *it is an executable program residing on server computer system that implements and manages the connection between the server computer system, the client computer system, and the digital camera.* (Morris, 7: 19-24.)

The Examiner in the Final Office Action states that "it is well known in the art that in order to establish a communication session between two devices a communication protocol is needed. It would have been obvious to one with ordinary skill in the art that it is inherent to have a communication protocol between two devices in order for the digital camera to transfer images to the host."

Applicants don't disagree that the existence of a protocol is inherent. However, Applicants respectfully submit that the digital camera determining communications information is not inherent, nor necessary in most systems. As noted in Morris, in a standard communications session, an executable program residing on the host device implements and manages the connection between the host and the digital camera. In contrast, in accordance with claim 1 of the present invention, the digital camera system "determining communication information allowing communication between the digital camera device and the particular host device" and "based on said determined communication information, establishing a communication session between the digital camera device and the particular host device, said communication session supporting photo-serving communication protocols that present the digital camera device as a file server to the host device."

Applicants respectfully dispute Examiner's assertion of inherency, and request a reference which actually teaches the determining of communication information by the digital camera device, as recited in claim 1.

Therefore, since the references alone or in combination do not teach or suggest "based on said determined communication information, establishing a communication session between the digital camera device and the particular host device, said

communication session supporting photo-serving communication protocols that present the digital camera device as a file server to the host device," Applicants respectfully request withdrawal of this rejection. Therefore, because not every element of claim 1 is disclosed in Tullis, Nakagiri, and Morris, whether considered separately or in combination, claim 1 and its dependent claims are patentable in view of Tullis, Nakagiri, and Morris.

Claim 21 recites in part "based on said determined communication information ... establishing a communication session between the portable device and the particular host device," and therefore claim 21 and its dependent claims are patentable in view of Tullis, Nakagiri, and Morris for at least the reasons articulated with respect to claim 1.

Examiner further added Steinberg, Ward, and Allen in rejecting claims dependent on claims 1 and 21 respectively.

Steinberg is directed at an apparatus to serve as an interface for enabling a user of a portable still and or video digital camera to send image data directly from the camera to a communication network for transmission and downloading to a remote network location or remote computer (Steinberg, 1: 43-48). Ward is directed at a network configuration file for automatically transmitting images from an electronic still camera (Ward, title). Allen is directed at an electronic imaging system capable of image capture, local wireless transmission and voice recognition (Allen, title). None of these references remedy the shortcomings of Tullis in view of Nakagiri and further in view of Morris, as discussed above with respect to claims 1 and 21. Therefore claims dependent on claims 1 and 21 respectively are not obvious over the references cited.

Examiner rejected claims 41, 43-45, 51, 59, and 62 under 35 U.S.C. §103(a) as being unpatentable over Endsley, in view of Nakagiri, further in view of Morris.

As noted correctly by Examiner, Endsley fails to teach “a communication module for establishing a communication session between the portable device and the particular host device.” Thus, Endsley also fails to teach “a communication module for establishing, based on said determined communication information, a communication session between the portable device and the particular host device,” as recited by claim 41 as amended. As discussed above, neither Nakagiri nor Morris, whether considered individually or in combination, disclose this element. Further, as also discussed above with respect to claims dependent on claims 1 and 21 respectively, additional references (i.e., Steinberg, Ward, and Allen) also fail to disclose this limitation. Examiner rejected claim 60 under 35 U.S.C. §103(a) as being unpatentable over Endsley in view of Nakagiri, further in view of Morris as applied to claim 41 above, and further in view of Inoue. Inoue is directed at reception method and apparatus for searching various first and second source devices adapted to send data signals to analog and optical input terminals (Inoue, title) and fails to disclose or suggest the above limitation.

Therefore, claim 41 and its dependent claims are not obvious over the references cited.

3. Conclusion

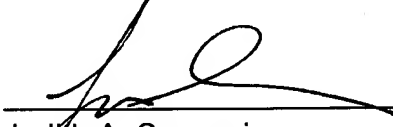
Applicant respectfully submits that in view of the amendments and discussion set forth herein, the applicable rejections have been overcome. Accordingly, the present and amended claims should be found to be in condition for allowance.

If a telephone interview would expedite the prosecution of this application, the Examiner is invited to contact Elena Dreszer at (408) 720-8300.

If there are any additional charges/credits, please charge/credit our deposit account no. 02-2666.

Respectfully submitted,
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